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| 10/521,981 | 01/21/2005 | Gerald Adams | J3682(C) | 1485 |

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UNILEVER PATENT GROUP
800 SYLVAN AVENUE
AG West S. Wing
ENGLEWOOD CLIFFS, NJ 07632-3100

| EXAMINER | |
|---|---|
| VU, JAKE MINH | |

| ART UNIT | PAPER NUMBER |
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| 1618 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/521,981 | ADAMS ET AL. | |
| | Examiner | Art Unit | |
| | JAKE M. VU | 1618 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *09 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-6 and 9-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 9-11* is/are rejected.

7)☒ Claim(s) *2* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/9/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

Receipt is acknowledged of Applicant's Amendment and Information Disclosure Statement filed on 07/09/2008.

- Claims 1, 2 and 6 have been amended.
- Claims 7-8 have been cancelled.
- Claims 9-11 have been added.
- Claims 1-6 and 9-11 are pending in the instant application.

### *Double Patenting*

Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over copending Application No. 10/521,982 in view of YUUKI et al (JP 08-092043) and BOLICH (US 4,764,363) **are maintained** for reasons of record in the previous office action filed on 04/09/2008.

Note, it is acknowledged that Applicant will consider filing a terminal disclaimer upon allowable subject matter.

### *Claim Objections*

Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 2 recites the same limitation that is in claim 1.

### *Claim Rejections - 35 USC § 112*

Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention **are withdrawn** in view of Applicant's cancellation of these claims.

However, upon further consideration, a new ground(s) of rejection is made as discussed below.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the term "and their emulsions" encompass. Please clarify.

### *Claim Rejections - 35 USC § 101*

Claims 7 and 8 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process **are withdrawn** in view of Applicant's cancellation of these claims.

***Claim Rejections - 35 USC § 102***

Claims 1-5, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by YUUKI et al (JP 08-092043) **are maintained** for reasons of record in the previous office action filed on 04/09/2008 and as discussed below.

Note, YUUKI teaches using amino modifying silicone (see translation on pg. 8, line 13), which reads on "amino functional silicones" as claimed by Applicant.

Upon further consideration of Applicant's Amendment, a new ground(s) of rejection is made as discussed below.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by GALLAGHER et al (EP 0424158).

Applicant's claims are directed to a method of styling hair by applying to the hair a hair treatment mousse comprising: 0.5-10% of 2-hydroxyalkanoic acid, such as 2-hydroxyalkanoic acid; less than 2% of a surfactant; a styling polymer.

GALLAGHER teaches a method of styling hair by applying to the hair a hair treatment mousse (see pg. 3, line 31) comprising: 1% of 2-hydroxyalkanoic acid, such as 2-hydroxyalkanoic acid (see pg. 1, line 45-51; and pg. 6, Example 4); less than 2% of

a surfactant (see pg. 6, Example 4); a styling polymer (see pg. 3, line 34); and perfume (see pg. 3, line 47).

***Claim Rejections - 35 USC § 103***

Claims 1-6 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over YUUKI et al (JP 08-092043) in view of BOLICH (US 4,764,363) **are maintained** for reasons of record in the previous office action filed on 04/09/2008 and as discussed below.

Note, YUUKI teaches using amino modifying silicone (see translation on pg. 8, line 13), which reads on "amino functional silicones" as claimed by Applicant.

Note, Applicant's disclosed that the prior art "mouse formulations are frequently applied to damp hair" (see pg. 1, line 11).

Upon further consideration of Applicant's Amendment, a new ground(s) of rejection is made as discussed below.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over GALLAGHER et al (EP 0424158) in view of BOLICH (US 4,764,363).

As discussed above, GALLAGHER teaches a method of styling hair by applying to the hair a hair treatment mousse (see pg. 3, line 31) comprising: 1% of 2-hydroxyalkanoic acid, such as 2-hydroxyalkanoic acid (see pg. 1, line 45-51; and pg. 6, Example 4); less than 2% of a surfactant (see pg. 6, Example 4); a styling polymer (see pg. 3, line 34); and perfume (see pg. 3, line 47).

GALLAGHER does not teach using a propellant or silicone based conditioners.

BOLICH teaches propellant are commonly used in styling mousse and silicone based conditioners provides a clean wet hair feel along with good styling retention.

It would have been obvious to the person of ordinary skill in the art at the time the invention was made to incorporate a propellant or silicone based conditioners into GALLAGHER's composition. The person of ordinary skill in the art would have been motivated to make those modifications, because the silicone would prolong styling retention and the propellant is needed in styling mousse, and reasonably would have expected success because GALLAGHER disclosed the 2-hydroxyalkanoic acid could be used with styling mousse.

The references do not specifically teach adding the ingredients in the amounts claimed by Applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ and reasonably would expect success. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus,

absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of Applicant's invention.

### *Response to Arguments*

Applicant argues that YUUKI is directed to a method of styling hair by applying a composition that includes, as styling ingredients, a combination of organic acid component (a) such as 2-hydroxyhexanoic acid and a sulfonic acid component (b), whereas Applicant's claims do not recite sulfonic acid. The Examiner finds this argument unpersuasive, because Applicant's claims are open language since these claims recite "comprising" and "consisting essentially of"' thus, these claims could include sulfonic acid component or other active agents, such conditioning materials, sun-screen agents, or styling polymer recited in Applicant's dependent claims 5 and 9. Additionally, Applicant's disclosed only one example, in which the composition has other ingredients, such as silicone, polyquaternium, cremophor, etc. (see pg. 14, Example 1).

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Telephonic Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAKE M. VU whose telephone number is (571)272-8148. The examiner can normally be reached on Mon-Tue and Thu-Fri 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618

Jake M. Vu, PharmD, JD
Art Unit 1618